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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/018,003	12/14/2001	Masao Matsuda	8013-1110	7116
466 7590 10/19/2007 YOUNG & THOMPSON 745 SOUTH 23RD STREET 2ND FLOOR ARLINGTON, VA 22202			EXAMINER CASLER, TRACI	
			ART UNIT 3629	PAPER NUMBER
			MAIL DATE 10/19/2007	DELIVERY MODE PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary	Application No. 10/018,003	Applicant(s) MATSUDA ET AL.	
	Examiner Traci L. Casler	Art Unit 3629	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 26 July 2007.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-4 and 6-16 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-4 and 6-16 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date: _____ |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date: _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

This action is in response to papers filed July 26, 2007.

Claims 1, 3, 616 have been amended.

Claims 1-4 and 6-16 are pending.

Claims 1-4 and 6-16 are rejected.

Continued Examination Under 37 CFR 1.114

1. A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on July 26, 2007 have been entered.

Claim Rejections - 35 USC § 112

2. The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

3. Claims 1-4 and 6-16 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the enablement requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to enable one skilled in the art to which it pertains, or with which it is most nearly connected, to make and/or use the invention. Claims 1-16 recite limitations in which the disclosure does not teach how

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one skilled in the art would make the present invention. The claims list growth stage identification, the disclosure make reference to this limitation but fails to identify how one goes about identifying a "growth stage" or what exactly is a growth state. The claims recite the limitation of "proficiency of study information", "study characteristics" and "study dependency" but again fail to teach how one would determine proficiency, characteristics, and dependency as well as what exactly is proficiency, characteristics and dependency or how these items are used to determine a growth stage. The examiner is unable to determine how the instant application teaches one to use a scholastic ability based on study time and the changes in study characteristic and a progress in transitioning to an independent study. The application lists these items but fails to teach how they are used in relation to one and under to determine a "growth stage". The disclosure lists what the different stages are but provides not instruction or guidelines on who one determines which stage the learner resides. How is scholastic ability based on study time and how are they both used in a function to determine the "study" growth. Lastly, the claims recite the limitation of determining study items, it is understood by the examiner that the study items are what will be learned by the students or taught to the students. However, the disclosure fails to teach how to determine what each individual is to receive as study items. What factors effect the final decision for appropriate study items.

4. Claim 16 is rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to reasonably convey to one

skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention. Claim 16 is teaching multiple study guidance's, however, the disclosure merely teaches a single guidance. The use of multiple guidance's leave the claims in a narrower scope than the disclosure; hence the disclosure would not lead one ordinary skill in the art to know that the single study guidance is the same as or different from the multiple guidance's and how would one make the multiple as opposed to the single. The applicants disclosure teaches a single study guide that contains multiple steps or stages not multiple study guidances.

5. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

6. The claims are generally narrative and indefinite, failing to conform with current U.S. practice. They appear to be a literal translation into English from a foreign document and are replete with grammatical and idiomatic errors.

Claim Rejections - 35 USC § 101

7. 35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

8. Claims 1-16 rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter. The claims fail to identify a concrete tangible

result. The claims are a subjective process of evaluating an individual's knowledge or level of knowledge in various areas. The evaluation has no set parameters for determining how individuals fall into a level or category of knowledge therefore can not produce a concrete tangible result. Furthermore, the claims also invention also depends on a "presence or absence" of interest and eagerness of the individual regarding the individual's studies. Not only are there not concrete process for identifying an individual's "presence or absence" of interest and eagerness, these are an individual's emotions and thoughts. Emotions and thoughts fall within the abstract idea of non-statutory subject matter. The individual's eagerness and/or interest can vary greatly depending on their state of being and their current life activities. An individual might not be very interested and/or eager to participate in a lesson when it is a beautiful day and they want to be outside. Whereas on a rainy day an individual's interest and/or eagerness could be higher because of a lack of other activities that interest them at the moment. The mere presentation of the study plan does not establish a "concrete" result. The result is not concrete in that the results are not repeatable. The disclosure provides not support on how one skilled in the art would use the items/stages/limitations to determine the study plan the results can not be repeated without undue experimentation. As there are several methods and modes for one to determine what one's study characteristics are, proficiencies are and measurements or progress in a study one skilled in the art would not know which method or mode to use in order to obtain the same.

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9. ****THE EXAMINER NOTES BELOW WILL BEGIN A REJECTION OF THE PRIOR ART, HOWEVER THE REJECTION IS BASED ON THE EXAMINERS BEST UNDERSTANDING OF THE CLAIMS AND WHAT THE APPLICANT IS TRYING TO CLAIM AS WELL AS HOW APPLICANTS CLAIMS ARE PERFORMED IN VIEW OF THE VARIOUS REJECTIONS MADE ABOVE UNDER 35 USC 112 IST AND 35 USC 101. repeatable results.**

10.

Claim Rejections - 35 USC § 102

11. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

12. Claims 1-4 and 6-16 are rejected under 35 U.S.C. 102(e) as being anticipated by US Patent 6,801,751 Wood et al; Interactive Learning Appliance. Hereinafter referred to as Wood.

13. As to claims 1 and 12-14 Wood teaches.

Servers connected to a network(Fig. 1 ref 17)

Study menu connected to server(Fig. 2 Ref. 23).

Study menu generation to save and present study menu(Fig. 3)

Learner history database(Fig. 3 Ref . 99)

Linking device for transferring data over the server(C. 7 I. 30-33).

Study material selected for the learner based on proficiency, time and level(C. 6 I. 41-49; 65-67 and C. 7 I. 1-12).

Presenting to the learner the appropriate study material in a time distributed manner C. 13 I. 34-45)

Define growth stages(zones) for moving from one stage to another(C. 7 I. 1-13).

14. As to claim 2 Wood teaches communication over the internet(C. 8 I. 15-18).
15. As to claim 3 Wood teaches authenticated and authorized access(C. 8 I. 8-9)
16. As to claim 4 Wood teaches a study menu displayed to the user(C. 2 I. 45-48).

As to claims 6-11 Woods teaches populating databases formatted with various information regarding the learner(C. 14 I. 46-67 c. 15 I. 1-15). The examiner notes that whereby, wherein clauses in a method is not given weight wherein the intended result of the process step positively recited; see *Minton v. National Association of Securities Dealers Inc* 67 USPQ2 d 1614 (CAFC 2003). The wherein clauses for the presentation and documentation merely express the type of information that is presented or document and does not result in an additional execution of a step. The wherein clauses of the system claims are merely differences only found in the nonfunctional descriptive material and are not functionally involved in the steps recited. The steps would be performed regardless of the type of information being used to populate the databases. Thus, this descriptive material will not distinguish the claimed invention from the prior art in terms of patentability, see in re *Gulack*, 703 F.2d 1381, 1385, 217 USPQ 401, 44(Fed. Cir. 1983); In re *Lowry*, 32 F.3d 1579, 32 USPQ 2d 1031(Fed. Cir. 1994),

17. As to claim 15 Wood teaches checking results reported by learning(responses) and reporting the time of the results and modifying the schedule according to the time require. Assessing if the user should continue on a "fast-track" study schedule or be dropped down to a standard pace or vice versa (C. 13 I. 35-54),

18. As to claim 16 Wood teaches altering or updating a study guide based on a learners understanding and/or progression of the current materials C. 18 I. 26-55)

Response to Arguments

19. Applicant's arguments with respect to claims 1-4 and 6-16 regarding the prior art rejections have been considered but are moot in view of the new ground(s) of rejection.

20. Applicant's arguments filed August 3, 2007, 112 1st and 101 rejections have been fully considered but they are not persuasive.

21. Applicant argues that the claims meet the statutory requirement under 35 USC 101 because they merely save and present study plan to the learner. The examiner notes that presenting the study plan does not make the results themselves concrete and tangible. The mere presentation of the study plan does not establish a "concrete" result. The result is not concrete in that the results are not repeatable. The disclosure provides not support on how one skilled in the art would use the items/stages/limitations to determine the study plan the results can not be repeated without undue experimentation.

22. As to applicants arguments that the claims are enabled by the disclosure. The applicant points to Fig 8 and Paragraph 39(of published application) . The examiner

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notes that the noted sections merely show that there are different growth stages but do not teach how one knows what quantifies a growth stage, how does one skilled in the art determine the growth stage to determine at appropriate study plan. Applicant further points to ¶ 48 which eligibly the "execution" of relating the growth stage. However, the paragraph is directed to determining degree of proficiency not a growth stage. The disclosure does not teach how to use that degree of proficiency to determine a growth stage. If a growth stage is based on a "scholastic ability" and a study characteristic" why is the applicant point a teaching of proficiency.

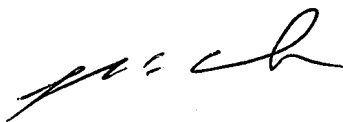
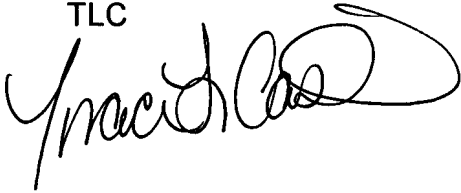
Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Traci L. Casler whose telephone number is 571-272-6809. The examiner can normally be reached on Monday-Thursday 6:00 am-4:30 pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, John Weiss can be reached on 571-272-6812. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

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